

REMARKS

Applicant amends claims 1, 8, 10, 19, and 20 to more clearly define the features of those claims.

Claims 1-20 are currently pending.

In the Office Action, the Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as unpatentable over International Publication No. WO 02/073933 to Hovell et al. (Hovell) in view of U.S. Patent Application Publication No. 2004/0107287 to Ananda et al. (Ananda). Applicant respectfully traverses this rejection.

Claim 1 defines an apparatus comprising:

a resolver configured to perform name resolving;

a first connector configured to provide a first direct connection to a first network, using a first network protocol;

a second connector configured to provide a second direct connection to a second network using a second network protocol, wherein, when the resolver in the first network forwards a name resolving request to a domain name service server in the second network, the name resolving request is sent directly from the resolver in the first network to the second network without using a network address translator server configured to process packets other than the name resolving request sent to the second network; and

a translator configured to perform address translation between the first network and the second network, the translator, separate from the network address translator server, performing address translation on the name resolving request sent directly to the second network without using the network address translator server;

wherein the resolver and the translator are configured to co-operate in order to translate addresses upon performing name resolving, and *wherein the resolver and the translator are configured on the same domain name server.*

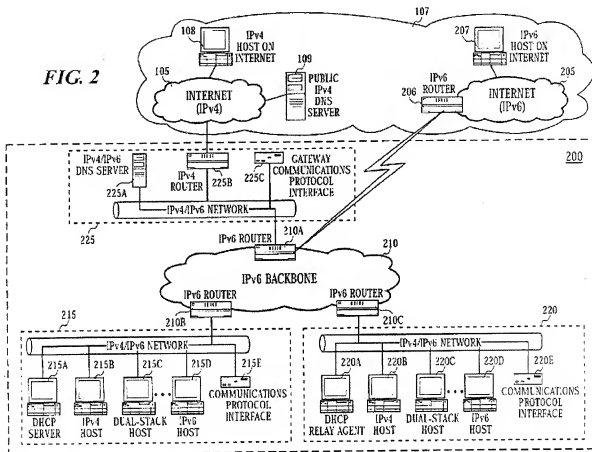
Emphasis added.

The Examiner acknowledges that Hovell fails to disclose at least the following feature of claim 1: "a second connector configured to provide a second direct connection to a second network using a second network protocol, wherein, when the resolver in the first network forwards a name resolving request to a domain name service server in the second network, the name resolving request is sent directly from the resolver in the first network to the second network, the name resolving request sent directly between the first network and the second network without using a network address translator server configured to process packets other than the name resolving request sent to the second network ... *wherein the resolver and the translator are configured on the same domain name server.*" Emphasis Added. Office Action, pages 5-6.

To cure the above-noted gap in Hovell, the Examiner relies on the Ananda DNS server 125. On page 13 of the Office Action, the Examiner says that Ananda's DNS does not require network address translation when using gateway multi-protocol subnet 225. Applicant disagrees.

First, Applicant submits that the Examiner has committed a clear error by modifying the embodiment of FIG. 1 depicting DNS 125 and the embodiment of FIG. 2 depicting gateway multi-protocol subnet 225. For at least this reason, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Moreover, the Examiner modifications to Ananda fly-in-the-face of Ananda's actual teachings. Specifically, Ananda's gateway multi-protocol subnet 225 includes a communication protocol interface (CPI) 225C, which performs address translation between networks. Ananda's FIG. 4 is reproduced below.



Specifically, when describing the CPI, Ananda states the following:

[0063] A communication protocol interface (CPI) comprises an IPv4 processor for processing IPv4 specific communication, an IPv6 processor for processing IPv6 specific communication, and a protocol converter for processing communication between the IPv4 and IPv6 processors. In a communication network for an organization, where an organization wide IPv6 communication backbone is employed, subnets of the communication network on the IPv6 communication backbone, comprise multi-protocol subnets and gateway multi-protocol subnets. A multi-protocol subnet has a mixture of IPv4, IPv6, and dual-stack hosts i.e. IPv4 and IPv6 hosts; and a CPI. In addition, a corresponding gateway multi-protocol subnet for communication beyond the communication network, include a gateway communication protocol interface (GCPI), which is coupled to the communication network and also to the Internet. The CPIs in the multi-protocol subnets transport IPv4 data packets across the IPv6 communication backbone encapsulated in IPv6 data packets between the subnets. This allows IPv4 hosts operating in one of the multi-protocol subnets, to communicate with IPv4 hosts in other

subnets of the communication network. In addition, the CPIs and GCPIs in the subnets also transport IPv4 data packets across the IPv6 backbone encapsulated in IPv6 data packets. This allows IPv4 hosts operating in any of the subnets, to communicate with IPv4 hosts on the Internet.

Indeed, the very purpose of Ananda is the CPI (see para. 0018). FIG. 3 of Ananda depicts the CPI. When describing the CPI, Ananda says that the CPI performs address translating:

[0104] When it is, then a first 64-bit portion of a IPv6 destination address of a resultant IPv6 data packet is constructed 425 with the first 48-bits, that was previously obtained forming the prefix; and then appending a predetermined 16-bit subnet ID (ffff) to the prefix. The first 64-bit portion of the IPv6 destination address addresses the IPv4 portion 105 of the Internet 107. *Next, the second 64-bit portion of the IPv6 destination address is constructed 430 by translating the 32-bit IPv4 destination address to a 32-bit hexadecimal, and then prefixing 32 zeros.*

Emphasis added.

It is clear from the above, that Ananda's DNS 125 (as well as DNS server 225A) must use the CPI 225C to perform all address translation. Therefore, it is clear that Ananda's DNS cannot possibly disclose or suggest the "resolver" and the "translator" recited above with respect to claim 1, much less "wherein the resolver and the translator are configured on the same domain name server," as recited in claim 1.

In view of the foregoing, neither Hovell nor Ananda discloses or suggests the above-noted feature of claim 1. Therefore, claim 1 and claims 2-7, at least by reason of their dependency from independent claim 1, are allowable over Hovell and Ananda, whether those references are taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of those claims should be withdrawn.

Independent claims 8, 10, 19, and 20, although of different scope, include one or more features similar to those noted above with respect to claim 1. For at least the

reasons given above with respect to claim 1, claims 8, 10, 19 and 20, as well as claims 9 and 11-18, at least by reason of their dependency from independent claims 8, 10, and 19, are allowable over Hovell and Ananda, whether those references are taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of those claims should be withdrawn.

Regarding the motivation to combine, M.P.E.P. 2143.01 states "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." Applicant submits that one of ordinary skill in the art would not be motivated to make the Hovell-Ananda combination proposed by the Examiner because the proposed modification of Ananda would make Ananda unsuitable for its intended purpose. Specifically, the very purpose of Ananda as stated in the Summary of the Invention relates to the CPI 225C performing address translation. As such, to perform the modifications proposed by the Examiner would defeat the very purpose of Ananda to provide a communication protocol interface device, as expressed in Ananda's Brief Summary of the Invention section. See, e.g., Ananda, para. 0019. Therefore, the rejection of claims 1-20 under 35 U.S.C. §103(a) as unpatentable over Hovell and Ananda should be withdrawn for this additional reason.

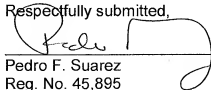
CONCLUSION

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Applicant asks that all claims be allowed.

Applicant is concurrently filing herewith a Petition for a one-month extension of time with the requisite fee. Authorization for a credit-card payment of the filing fees mentioned above is submitted herewith. No additional fees are believed to be due, however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 39700-501001US/NC31574US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

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Respectfully submitted,



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